Mailed:
March 3, 2006
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Immunex Corporation

v.

Applied Medical Research, Inc.

Opposition No. 91153080
against Serial No. 75704454

Lisa Peller London, Laurence R. Hefter, Andrea Anderson and Margaret A. Esquenet of Finnegan Henderson Farabow Garrett & Dunner, L.L.P. for Immunex Corporation.

Edward J. Petrus, M.D., Medical Director of Applied Medical Research, Inc., *pro se*.

Before Seeherman, Bucher and Walsh, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Applied Medical Research seeks registration on the Principal Register of the mark **IMMUNO-RX** *(standard character drawing)* for goods identified in the application as follows:

> "Vaccines composed of killed bacterial bodies and their lysates and probiotic bacteria for use in stimulating the immune system" in International Class 5.[1]

[1] Application Serial No. 75704454 was filed on May 13, 1999 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

Immunex Corporation has opposed the application on the following grounds: alleging that applicant's mark, when used on the identified goods, so resembles opposer's previously used and registered mark **IMMUNEX** *(standard character drawing)* for "pharmaceuticals for the treatment of autoimmune diseases, healing wounds, and cancer" also in International Class 5,[2] as to be likely to cause confusion, to cause mistake or to deceive; and alleging that applicant's mark so resembles opposer's mark as to cause dilution of the distinctive quality of opposer's mark, which was distinctive and became famous before applicant filed the instant application.[3]

In its answer, applicant has denied the salient allegations of the notice of opposition. Only opposer timely filed a brief in this case.[4] Neither party requested an oral hearing.

---

[2] Registration No. 1689809, registered on June 2, 1992, claiming first use anywhere since at least as early as January 4, 1988 and claiming first use in commerce since at least as early as September 9, 1991. Section 8 affidavit accepted and Section 15 affidavit acknowledged; first renewal granted.

[3] In its brief, opposer also claims that this application should be barred from registration because applicant lacks a *bona fide* intention to use its mark in commerce. However, this ground was not included in the original notice of opposition, the pleadings were never amended to include it as a pleaded ground, and there is nothing in the record to support a contention that the parties have tried this issue.

[4] Opposer's motion to strike applicant's brief as untimely was granted on September 28, 2005.

The record includes the pleadings; the file of the opposed application; and the testimony declaration, with exhibits, of opposer's sales representative, Mark Snyder, that opposer filed on December 15, 2004.[5] Additionally, on November 19, 2004, opposer submitted under its First Notice of Reliance a status and title copy of its pleaded Registration No. 1689809 for the mark **IMMUNEX**; on November 22, 2004, opposer submitted under its Second Notice of Reliance a copy of applicant's responses to opposer's First Set of Interrogatories and a copy of applicant's supplemental responses to opposer's first set of interrogatories; and on December 14, 2004, opposer submitted under its Third Notice of Reliance articles from the LEXIS/NEXIS database which qualify as printed publications under Trademark Rule 2.122(e).[6]

Applicant has not submitted any evidence,[7] nor has applicant objected to any of the evidence opposer entered into the record.

---

[5] According to a submission of December 7, 2004, the parties stipulated to taking testimony by declaration or affidavit.

[6] To the extent that several of these excerpts were from wire service reports, and there is no evidence that these articles ever circulated in the United States, we have not considered them.

[7] Applicant submitted no notice of reliance and no testimony or exhibits during its testimony period, although the record reveals allegations made in its answer that were never proven, as well as inappropriate attachments of newspaper articles and other papers to various motions and responses filed throughout the litigation but that were never correctly submitted for the record.

The record shows that opposer was a pioneer in the field of biotechnology as early as 1981. Immunex Corporation has had one major, breakthrough drug, sold under the mark ENBREL. This drug, whose generic name is etanercept, is an injectable rheumatoid arthritis treatment, initially targeted to adults. It is a type of protein that blocks the action of tumor necrosis factor (TNF) – a substance created naturally by the body's immune system. People with immune diseases, such as rheumatoid arthritis, ankylosing spondylitis, psoriatic arthritis, and psoriasis, have too much TNF in their bodies. The ENBREL pharmaceutical can reduce the amount of TNF in the body to normal levels, helping to treat such diseases.

The record shows that Immunex Corporation faced some widely-publicized challenges and failures in 2001 to produce enough ENBREL medication to meet increasing demand. In July 2002 Amgen bought Immunex Corporation for ten billion dollars, in what was at that time the largest acquisition ever of a biotech drug maker.[8]

[8] Applicant attempted to show examples of where this deal was much criticized in the financial press as a huge gamble, or even a serious misstep, for Amgen. None of this material was properly made of record. Nonetheless, there are LEXIS/NEXIS articles placed into the record by opposer from this period containing references to many of these same challenges.

Since the sale of Immunex Corporation to Amgen, the ENBREL drug has been marketed in North America jointly by Amgen and Wyeth Pharmaceuticals. At the time of the purchase, the URL for Immunex Corporation's website (www.immunex.com) was changed to www.amgen.com. However, Immunex Corporation continues to be a wholly-owned subsidiary of Amgen; is responsible for manufacturing ENBREL medication; and owns the trademark registration for, and common law rights in, IMMUNEX.

Amgen continues to use the trade name Immunex Corporation on the ENBREL product – a medication that has been distributed to more than 250,000 patients worldwide.[9]

STANDING AND PRIORITY

Initially, we find that based upon the submission into the record of its federal trademark registration, opposer has demonstrated standing in this case. Further, in view of that registration, priority is not in issue. *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

[9] "Over 250,000 patients worldwide have used ENBREL, and the IMMUNEX mark and name has appeared on all packaging and literature for that product." ¶ 16, Testimony Declaration of Mark Snyder.

LIKELIHOOD OF CONFUSION

We turn then to a consideration of whether opposer has proven a likelihood of confusion. Our determination under Section 2(d) of the Trademark Act is based upon an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relationship of the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The Goods

We turn first to the *du Pont* factor focusing on the similarity and nature of the goods as described in applicant's application compared with the goods listed in opposer's registration. The identifications of goods in both opposer's registration and the opposed application refer to "immune" and "autoimmune." However, we must look beyond this mere use of similar language and examine the respective identifications carefully in their entireties to determine whether the goods of the parties are similar.

Applicant's goods, as identified in its application, are "vaccines composed of killed bacterial bodies and their lystates and probiotic bactieria for use in stimulating the immune system." We view applicant's identification of goods as two distinctly different items, namely ❶ "vaccines composed of killed bacterial bodies and their lystates" and ❷ "probiotic bacteria for use in stimulating the immune system." This interpretation is supported by applicant's supplemental responses to opposer's interrogatories. In responses prepared by applicant on October 29, 2003, to questions about applicant's intended products, the timing of affected products, anticipated channels of trade, intended classes and types of consumers, etc., applicant said that " … the mark has not been used and is [sic] currently in use, but anticipate its use in dietary supplements and immunostimulants in the future." We view applicant's response as indicating that its probiotic bacteria product is different from its ethical pharmaceutical in the nature of a vaccine (i.e., the first phrase of its identification of goods, *supra*).

As for opposer's goods, much of the focus of opposer's evidence has been on opposer's "pharmaceuticals for the treatment of autoimmune diseases," such as its ENBREL drug. However, inasmuch as any comparison of the goods must be

made on the basis of how the parties' goods are identified in their respective registration and application, we note that opposer's goods include a much broader range of medical preparations than this narrow formulation, including "pharmaceuticals for the treatment of … healing wounds and cancer." *See Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.,* 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) [the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in an opposer's registration, rather than what the evidence shows the goods and/or services to be].

As noted, applicant's probiotic bacteria[10] are intended to be sold in the medium of a dietary supplement. Such products may be sold over-the-counter to members of the general public. Further, whether the bacteria are sold as ingredients of a dietary supplement, or as the dietary supplement itself, ultimate consumers would encounter the

[10] We take judicial notice of the definition of the term, probiotic: **"Probiotic** *noun* Definition: a preparation (as a dietary supplement) containing live bacteria (as *lactobacilli*) that is taken orally to restore beneficial bacteria to the body." *MERRIAM-WEBSTER'S COLLEGIATE DICTIONARY* (Eleventh ed. 2003).

trademark, either for the product or as an ingredient in the product. The ultimate users of "pharmaceuticals for the treatment of autoimmune diseases, healing wounds and cancer" would also include ordinary consumers. Even if the pharmaceuticals were sold by prescription, the trademark is likely to be encountered by these same ultimate users. In this connection, we note that:

> … the parties' drugs, *as identified*, also could be dispensed outside of the hospital setting, such that the ultimate users will have direct contact with them. As stated in *KOS Pharmaceuticals Inc.*, [369 F.3d 700, 70 USPQ2d 1874 (3rd Cir. 2004)], citing *Checkpoint Sys., Inc. v. Check Point Software Techs., Inc.*, 269 F.3d 270, 285 [60 USPQ2d 1609] (3rd Cir. 2001), "[w]here both professionals and the general public are relevant consumers, 'the standard of care to be exercised … will be equal to that of the least sophisticated consumer in the class.'" Thus, we must be sensitive to the fact that patients from the general public will not exercise the degree of care exhibited by medical professionals. As also stated by the Third Circuit in *KOS Pharmaceuticals Inc.*, *id.*: "While doctors and pharmacists play a gate-keeping role between patients and prescription drugs, they are not the ultimate consumers. Patients are. Courts have noted that drugs are increasingly marketed directly to potential patients through, for example, 'ask-your-doctor-about-Brand-X' style advertising."

Alfacell Corp. v. *Anticancer Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004) [respondent's ONCASE mark for "therapeutic compositions containing reagents for in vivo anticancer use"

is likely to cause confusion with petitioner's ONCONASE mark for "pharmaceuticals, namely, anticancer drugs"].

Accordingly, the goods of the opposer and applicant, as identified in their respective registration and application, could include goods directed to members of the general public, as well as to professionals, such as physicians and pharmacists. Because the goods are broadly identified, the identifications could include goods that address conditions that may affect the same individuals.

It is well settled, in this regard, that goods need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. *See* *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590, 595-96 (TTAB 1978); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

As noted above, because the respective identifications of goods could include products that address conditions that may affect the same individuals, and hence might well be

purchased and used by the same individuals, we conclude that the goods of the parties, as identified, are related.

Trade channels

In determining the similarity or dissimilarity of established, likely-to-continue trade channels, we must consider how the parties' goods are identified in their respective registration and application. Neither has any restrictions as to the channels of trade. In the absence of any specification that opposer's listed goods are sold by prescription, we must assume, at the very least, that the pharmaceuticals for the treatment of healing wounds would be sold over-the-counter. We must presume that such products could be found in the same channels of trade as would applicant's over-the-counter, nutraceutical/dietary supplement products, especially in drug stores. Hence, we find that the channels of trade are the same or overlapping.

Conditions of sale

As to the conditions under which and buyers to whom sales are made, in the event both parties would be marketing over-the-counter goods through the same channels of trade, there would be an overlap in consumers. Although the parties' products are for general health purposes, items such as wound care products and dietary supplements are

rather inexpensive items, and due to their nature, they are not necessarily going to be purchased using a great degree of deliberation or care.

The Marks

We turn next to the *du Pont* factor focusing on the similarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. Applicant's mark is **IMMUNO-RX** and opposer's mark is **IMMUNEX**. As to connotation, both marks suggest a connection with the immune system. There are also similarities in the appearance and pronunciation of the two marks in that both begin with "IMMUN," followed by a vowel, and end with the letter "X." While there are some differences in the middle of the marks, and in particular, applicant's mark contains a hyphen, these differences are not sufficient to distinguish the marks.

Under actual market conditions, consumers generally do not have the luxury of making side-by-side comparisons. The proper test in determining likelihood of confusion is not a side-by-side comparison of the marks, but rather, the decision must be based on the similarity of the general overall commercial impressions engendered by the involved

marks. *See Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation*, 206 USPQ 255 (TTAB 1980).

Thus, although there are some differences in the marks, we find that the marks are similar in their entireties as to appearance, sound, connotation and commercial impression.

The renown of the IMMUNEX mark

The record shows that the major trademark asset of Immunex Corporation over the years has been the intellectual property right associated with the ENBREL etanercept pharmaceutical. The research, promotional and sales figures that have been made a part of this record are primarily directed to this product.

As to the IMMUNEX mark, throughout this litigation applicant has taken the position that Immunex Corporation abandoned its rights in the IMMUNEX mark in July 2002 – at the time Amgen acquired Immunex Corporation. However, in the absence of a counterclaim or a cancellation proceeding, applicant cannot attack opposer's registration, and we must accord opposer's registration all the presumptions we would accord to any duly registered mark.

Moreover, on the merits of this claim, we find that this was not the case. Rather, the record shows that Immunex Corporation continues to be a wholly-owned

subsidiary of Amgen, is responsible for manufacturing ENBREL, and owns the subsisting trademark registration for, and common law rights in, IMMUNEX.

According to opposer's testimony, Amgen continues to use "Immunex Corporation" in connection with the ENBREL product. However, the record contains no copies of any labels showing how prominently the word IMMUNEX appears on the ENBREL label. Therefore, we cannot determine whether it would make an impression on consumers. We also note that media references since 2002 refer only to the name, "Immunex Corporation," in connection with Amgen's historical purchase in July 2002 of the company that makes the ENBREL pharmaceutical – never to IMMUNEX as a product mark.

In spite of this record, opposer argues that its IMMUNEX trademark has achieved "widespread recognition and fame in the field of pharmaceuticals and biotechnology." We disagree. To the extent opposer has shown the expenditure of substantial sums of money on research and development and marketing efforts, leading to a substantial sales volume of products (especially ENBREL etanercept), it is not clear how this expenditure, and consequent sales, supports a claim of widespread recognition for its IMMUNEX mark. Since Amgen's acquisition of Immunex Corporation in 2002, it is unclear

that even the financial world continues to place significance on the name IMMUNEX. In short, we find on this record that opposer has failed to establish that opposer's mark has achieved widespread recognition.

Accordingly, while we must accord this registered mark all of the statutory presumptions that attach to opposer's subsisting registration, we find the record deficient in making the case that IMMUNEX is a well-known mark. The factor of fame is therefore neutral.

Absence of actual confusion

While the record contains no instances of actual confusion, this is certainly not surprising in a case such as this. We note that applicant's application is still an intent-to-use application, and there is absolutely no evidence that applicant has begun using its mark. Therefore, as far as we can tell from this record, there has been no opportunity for confusion to occur.

Resolving doubt

It has often been stated that any doubts about likelihood of confusion under § 2(d) of the Act must be resolved against applicant as the newcomer. *In re Pneumatiques, Caoutchouc Mfr.*, 487 F.2d 918, 179 USPQ 729

(CCPA 1973). We note that when marks are used on pharmaceutical preparations and confusion can lead to serious consequences, it is even more important to avoid that which will cause such confusion. *See* *Blansett Pharmacal Co. Inc. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473 (TTAB 1992); and *American Home Products Corporation v. USV Pharmaceutical Corporation*, 190 USPQ 357 (TTAB 1976). Thus, in this case, which involves pharmaceutical and/or nutraceutical products, there is an even stronger reason for resolving doubt in this manner.

Conclusion on Likelihood of Confusion

Accordingly, we find that applicant's use of the mark **IMMUNO-RX** for, *inter alia*, probiotic bacteria for use in stimulating the immune system, is likely to cause confusion with opposer's mark **IMMUNEX**, registered for pharmaceuticals for the treatment of autoimmune diseases, healing wounds, and cancer.

In making our decision herein, we have given no weight to opposer's arguments regarding the alleged fame of the IMMUNEX mark. Although opposer has shown significant sales and advertising of its ENBREL product, no such evidence has been submitted for the IMMUNEX mark. Because of the manner in which the mark ENBREL has been used and promoted, it is,

as we stated previously, the term that enjoys the primary recognition, and the evidence of record does not persuade us that this same recognition would apply to IMMUNEX.

Dilution

The second ground asserted by opposer is that of dilution. Section 43(c)(1) of the Trademark Act, 15 U.S.C. § 1145, provides that "[t]he owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark, and to obtain such other relief as is provided in this subsection." Section 13(a) of the Act, 15 U.S.C. § 1063(a), makes this ground available for opposition proceedings. As set out in the Act itself, and as interpreted by case law, a threshold requirement for proving a dilution claim under the Federal Trademark Dilution Act of 1995 (FTDA) is the fame of opposer's mark. *See Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164 (TTAB 2001).

Well-known mark status, or fame, for likelihood of confusion purposes, and fame for dilution purposes are distinct concepts. *Palm Bay Imports Inc. v. Veuve Clicquot*

Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). Dilution fame requires that the mark is a member of a "select class" of marks. Establishing fame for FTDA purposes presents a much higher burden on applicant than simply showing general advertising and sales figures and unsupported assertions of fame. *Palm Bay Imports Inc. v. Veuve Clicquot, supra*, at 1694*; and Toro Co. v. ToroHead Inc., supra* at 1179 – 84.

However, we have already found that opposer has failed to prove that IMMUNEX is a well-known mark in our likelihood of confusion analysis. Therefore, given the stricter standard required to prove fame in order to obtain protection under the dilution statute, it is clear that opposer has not proven that IMMUNEX is famous for dilution purposes during any relevant time period. *See Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811, 1822 (TTAB 2005). Accordingly, we find that opposer has failed to establish its claim of dilution.

Decision: The opposition is dismissed on the ground of dilution, but sustained on the ground of likelihood of confusion.